

REMARKS

In the Office Action mailed June 30, 2005, the Examiner has raised the following issues, which are set forth by number below in the order they are addressed herein:

- 1) Claims 1-12, 14-23, 25 and 29-39 stand rejected under 35 USC § 102(e), as allegedly anticipated by U.S. Patent No. 6,550,914 to Kopfer;
- 2) Claims 1-9, 11, 12, 14-24, 29, 34-36, 40 and 41 stand rejected under 35 USC § 102(b), as allegedly anticipated by U.S. Patent No. 3,945,044 to McGee *et al.*;
- 3) Claim 13 stands rejected under 35 USC § 103(a), as allegedly unpatentable over U.S. Patent No. 6,550,914 to Kopfer;
- 4) Claims 27 and 28 stand rejected under 35 USC § 103(a), as allegedly unpatentable over U.S. Patent No. 6,550,914 to Kopfer, in view of U.S. Patent No. 6,364,479 to Wu; and
- 5) Claim 26 stands rejected under 35 USC § 103(a), as allegedly unpatentable over U.S. Patent No. 6,550,914 to Kopfer, in view of U.S. Patent No. 5,619,750 to Allewalt.

Applicant hereby amends Claims 1, 13-15 and 29, and cancels Claims 2, 3, 11, 12, 16, 22 and 23, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments. Applicant reserves the right to prosecute the original, similar, or broader claims in one or more future application(s). These amendments do not introduce new matter. Moreover, these amendments are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) The Claims Are Novel Over The '914 Patent

The Examiner has rejected Claims 1-12, 14-23, 25 and 29-39 under 35 USC § 102(e), as allegedly anticipated by U.S. Patent No. 6,550,914 to Kopfer ('914 Patent). The Examiner states that:

Kopfer discloses eyewear with filter ventilation compris[ing] a front frame 10 formed from a resilient material for holding a pair of lenses 14, a ventilation liner can be constructed from the same material as the frame, wherein the ventilation

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

liner 42 [is] contoured to fit a wearer's face closely while spacing the lenses from the wearer's face to create a dead space 26 between the user's eye and the lenses, the ventilation liner also be provided with a plurality of upper grooves 50 and lower grooves 50 (Office Action, page 2).

Applicant respectfully disagrees that the '914 Patent anticipates the claims. Nonetheless, Applicant has amended Claims 1, 13-15 and 29, and canceled Claims 2, 3, 11, 12, 16, 22 and 23, in order to further the prosecution of the present application and Applicant's business interests, without acquiescing to the Examiner's arguments, yet reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, Applicant has amended Claims 1 and 29 to recite "wherein said front surface comprises **indirect baffled vents** for channeling airflow through said deadspaces" and "said back surface comprises a **serrated pattern**." In addition, Claims 13 and 14 have been amended to depend upon Claim 1. Support for these amendments is found in, for example, original Claims 11 and 15. Further support is found in Figures 3, 5, 7 and 8, which depict exemplary eyewear inserts having indirect baffled vents.

The '914 Patent provides eyewear having an insert with direct vents in the form of *filtered ventilation grooves* (e.g., as described in Claim 1 and Column 5, lines 62-65, and as depicted in Figure 6). For example, the '914 Patent discloses that as:

the user moves, air is directed through both ventilation opening 18 and through grooves 50, 50' where any particulate matter is trapped by filter elements 28, 28' ('914 Patent, at column 5, lines 62-65).

In contrast, the present claims recite *indirect baffled vents*. The '915 Patent does not teach this element. Moreover, the '914 Patent fails to teach or suggest a pattern on the back surface of the eyewear insert, let alone a serrated pattern as recited in the present claims. As the '914 Patent does not teach or suggest two elements of the amended claim set, the '914 Patent clearly does not anticipate the claims. Thus, Applicant respectfully requests that this rejection be withdrawn.

2) The Claims Are Novel Over The '044 Patent

The Examiner has rejected Claims 1-9, 11, 12, 14-24, 29, 34-36, 40 and 41 under 35 USC § 102(b), as allegedly anticipated by U.S. Patent No. 3,945,044 to McGee *et al.* ('044 Patent).

The Examiner states that:

McGee *et al.* discloses goggle and accessories therefore compris[ing] a front frame 10 formed from a resilient flexible material such as soft plastic or soft rubber for holding a lens 90, a ventilation liner can be constructed from the same material as the frame, wherein the ventilation liner [is] contoured to fit a wearer's face closely while spacing the lenses from the wearer's face to create a dead space between the user's eye and the lenses, the ventilation liner [can] also be provided with a plurality of upper grooves 30 and lower grooves 30, wherein the lens is interchangeable (Office Action, page 3).

Applicant respectfully disagrees that the '044 Patent anticipates the claims.

Nonetheless as described above in Section 1, Applicant has amended Claims 1 and 29 to recite "wherein said front surface comprises **indirect baffled vents** for channeling airflow through said deadspaces" and "said back surface comprises a **serrated pattern**."

The '044 Patent provides a goggle with a disposable tear-off lens and an insert with direct vents in the form of *large filtered ventilation openings* as shown in Figures 1 and 5. In particular, the '044 Patent discloses that:

the air-flow ventilation means comprises a plurality of large vent openings 30 formed by ribs 32 which join the rim 12 to the forward section 22. On the exterior side, the ribs define with the rim 12 and forward section 22 a channel 34 for a fibrous or foam-type lining 36 which covers the openings to allow a slow exchange of atmosphere ('044 Patent, at column 3, lines 23-31).

Moreover, the '044 Patent fails to teach or suggest a pattern on the back surface of the eyewear insert. As the '044 Patent does not teach or suggest two elements of the amended claim set, the '044 Patent clearly does not anticipate the claims. Thus, Applicant respectfully requests that this rejection be withdrawn.

3) The Claims Are Nonobvious Over The '914 Patent

The Examiner has rejected Claim 13 under 35 USC § 103(a), as allegedly unpatentable over U.S. Patent No. 6,550,914 to Kopfer ('914 Patent). The Examiner states that:

Kopfer does not disclose the vent grooves for forcing incoming air to make a ninety degree turn before entering the dead space. Although the Kopfer device does not teach the exact configuration of the groove as claimed by Applicant, the configuration differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious (Office Action, pages 3 and 4).

Applicant must respectfully disagree that Claim 13, is obvious over Applicant's prior art patent. In the first place, Applicant traverses the Examiner's unsupported statement that the configuration of the claimed vent grooves is simply a design choice lacking functional consequences. Applicant asserts that the Examiner must provide documentary evidence (MPEP 2144.03, C), which was not done in the instant office action. Applicant also contends that the Examiner has failed to establish a prima facie case of obviousness for Claim 13. The single reference cited by the Examiner fails to teach an **improved venting means** in the form of indirect baffled vents that force incoming air to make at least one 90 degree turn before entering the deadspaces between as eyewear frame or lens, and skin around a wearer's eyes. Additionally, the Examiner has failed to point to a motivation *in the art* to modify this reference.

Importantly, it is the indirect baffled vents of the claimed eyewear insert that permit the elimination of a ventilation filter means utilized in the ventilation liner of the '914 Patent, while retaining the wind-retarding function of the ventilation filter means. Thus, the claimed invention omits an element required by the prior art, while retaining its function. The Examiner is respectfully reminded that the "omission of an element and retention of its function is an indicia of unobviousness" (MPEP 2144.04 II, B).² Accordingly, Applicant respectfully requests that this rejection be withdrawn.

**4 & 5) The Claims Are Nonobvious Over The '914 Patent In Combination
With The '479 Patent Or The '750 Patent**

The Examiner has rejected Claims 27 and 28 under 35 USC § 103(a), as allegedly unpatentable over U.S. Patent No. 6,550,914 to Kopfer ('914 Patent), in view of U.S. Patent No. 6,364,479 to Wu ('479 Patent); and has rejected Claim 26 under 35 USC § 103(a), as allegedly


² Citing *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

unpatentable over the '914 Patent, in view of U.S. Patent No. 5,619,750 to Allewalt ('750 Patent). Applicant respectfully disagrees that the claimed invention is obvious over the '914 Patent in view of the '479 Patent and/or the '750 Patent. Nonetheless, as noted above, the claims have been amended. In light of these amendments, it is noted that the '914 Patent, the '479 Patent and the '750 Patent all fail to teach or suggest an eyewear insert comprising an inner liner with a front surface comprising **indirect baffled vents** for channeling airflow and a back surface comprising a **serrated pattern**. As the prior art combination fails to teach or suggest two elements of the claimed invention, Applicant respectfully requests that these rejections be withdrawn.

CONCLUSION

Applicant believes the amendments and arguments set forth above traverse the Examiner's rejections and, therefore requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

Dated: September 30, 2005

By: 
Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500